

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s): Brian J. Reistad et al.
Appl. No.: 09/054,180
Conf. No.: 2217
Filed: April 1, 1998
Title: ELECTRONIC COMMERCE SYSTEM
Art Unit: 3621
Examiner: Pierre E. Elisca
Docket No.: 0115274-0008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' REPLY BRIEF

Sir:

I. INTRODUCTION

Appellants submit Appellants' Reply Brief in response to the Examiner's Answer dated September 21, 2007, 2007 pursuant to 37 C.F.R. § 41.41(a). It is Applicant's understanding that the Examiner's Answer dated August 10, 2007 was issued in error, as it addresses the *Candelore* and *Civanlar* references that were the subject of Appellant's earlier Appeal Brief dated September 7, 2004. These rejections were subsequently withdrawn. While a telephone call with the examiner confirmed this error, there does not appear to be any acknowledgement of this in the record.

With this Reply Brief, Appellants respectfully maintain the Examiner's Answer has failed to remedy the deficiencies with respect to the Final Office Action dated June 14, 2006 as noted in Appellants' Appeal Brief filed on April 16, 2007. Accordingly, Appellants respectfully request that the rejections of pending Claims 12-36 and 39-63 be reversed.

I. REGARDING CLAIMS 12-36 AND 39-63, BARNETT FAILS TO DISCLOSE EVERY FEATURE RECITED IN THE CLAIMS.

At the outset, Appellant respectfully objects to the manner in which the present application is being examined and appealed. The present application is being appealed for the second time before this board, and it appears that Appellant is not being given a full and fair opportunity to confront the rejections being levied against the claims.

Despite providing detailed reasons for reversal in the Appeal Brief, Applicant now notes that the Answer appears to be a complete replication (i.e., a cut-and-paste copy, including typographical errors) of the Final Office Action, without addressing or even acknowledging Appellant's arguments made in the Brief:

(1) Compare:

Examiner's Answer: "Claim Rejections - 35 U.S.C. §102", pages 3-8,
with
Final Office Action dated June 14, 2006, pages 2-6;

(2) Compare:

Examiner's Answer "Response to Arguments" pages 8-9,
with
Final Office Action pages 7-8.

(3) See also bottom of page 9 of Examiner's Answer: "For the reason state above [sic] this action is made final."

Appellant is aware of the provisions of MPEP §1207.02, which states that "If there is a complete and thorough development of the issues at the time of final rejection, it is possible to save time in preparing the examiner's answer required by 37 CFR § 41.39 by copying a rejection from a prior Office Action and then pasting the copied rejection into the answer." However, the provision only relates to a rejection from a prior Office Action; this provision does not give the Office license to copy an entire Office Action and use it as the sole basis for an Examiner's Answer. In order for this Board to effectively adjudicate the disputed issues without remand, it

is incumbent that both parties clearly present their arguments for consideration. Appellant respectfully submits that the examiner has not met this burden in the present appeal.

Furthermore, it is respectfully submitted that the issues were not "complete," nor were they "thoroughly developed" at the time of final rejection. Indeed, Appellant contacted the responsible examiner at the time of the final rejection (F. Backer) to discuss the perceived infirmities of the rejection, and the discussion was placed in the record by the Appellant (see Appellant's Brief, page 23, 2nd full paragraph, page 25, 2nd-3rd paragraph). Additionally, Appellant pointed out two glaring omissions in the *Barnett* reference, during the interview, regarding the features reciting that coupons are accepted "from another computer" and "without regard to the identity of the coupon holder" (see Appellant's Brief, page 25, 2nd and 3rd paragraphs). Despite this, Appellant has not received any substantive response from the Office regarding these deficiencies, as well as the other deficiencies argued by the Appellant.

As the Examiner's Answer fails to rebut any of Appellant's arguments set forth in the Brief, Appellant submits that the rejections pertaining to independent claims 12-14, 34-36, 39-41 and 61-63 are improper and should be reversed. Appellant also submits that the patentability of the independent claims renders moot the rejections to dependent claims 15-33 and 42-60.

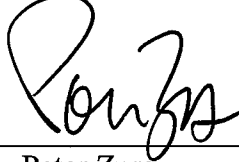
IV. CONCLUSION

For the foregoing reasons, Appellants respectfully submit that the Examiner's Answer does not remedy the deficiencies noted in Appellants' Appeal Brief with respect to the Final Office Action. Appellants respectfully submit that the Patent Office has failed to establish that *Barnett* teaches all of the claimed features of Claims 12-36 and 39-63. Accordingly, Appellants respectfully submit that the rejections are erroneous in law and in fact and should therefore be reversed by this Board.

No fee is due in connection with this Reply Brief. The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 115274-008 on the account statement.

Respectfully submitted,

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